



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097079, 942	05/15/98	REDDY	

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON MA 02109

HM42/0106

EXAMINER
SOLOLA

ART UNIT	PAPER NUMBER

01/06/99

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/079,942

Applicant(s)

Reddy et al.

Examiner

Taofiq Solola

Group Art Unit

1613

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) 1 and 17 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2 and 3 is/are rejected.

☒ Claim(s) 4-16 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3,5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to compounds, classified in class 549, subclass 416+.
 - II. Claims 2-3, drawn to compounds, classified in class 552, subclass 653.
 - III. Claim 17, drawn to packaged compound, classified in classifiable in class 424.

Claims 4-16 would be examined with the elected invention commensurate in scope therewith.

2. The inventions are distinct, each from the other because of the following reasons: The inventions of groups I-III are independent and distinct because there is no patentable co-action among the various groups, and a reference anticipating one member will not render another obvious.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Ms. Elizabeth Hanley on 12/29/98 a provisional election was made with traverse to prosecute the invention of group II, claims 2-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 and 17 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Muralidharan et al., J. Org. Chem., 1993, 58(7), pages 1895-1899.

Muralidharan et al., disclose compound 4a on page 1896.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arch. of Biochem and Biophysics, vol. 329(2), 1996, pages 228-234.

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Applicant claim compounds having generic formula II. Fleet et al., teach compound (1 α , 3 α), figure 1, page 229. The difference between the instant invention and that of Fleet et al., is that applicant's structure is an enantiomer instead of racemate structure by Fleet et al. Enantiomers and racemate are prima facie obvious absent a showing of unexpected results. In re Adamson, 125 USPQ 233. It would have been suggested to one of ordinary skill in the art to make the enantiomer. The motivation is to make additional compounds having antiproliferative effect.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy et al., Biochemistry, vol. 28(4), 1989, pages 1763-1769.

Applicant claim compounds having generic formula II (claim 2) and related specific species (claim 3). Reddy et al., teach compounds as shown on pages 1766 and 1768. The difference between the instant invention and that of Reddy et al., is that applicant's structure is an enantiomer instead of racemate structures by Reddy et al. Enantiomers and racemate are prima facie obvious absent a showing of unexpected results. In re Adamson, 125 USPQ 233. It would have been suggested to one of ordinary skill in the art to make the enantiomer. The motivation is to make additional compounds having antiproliferative effect.

Objections

Claims 4-16 are objected to because, they contain non-elected subject matter.

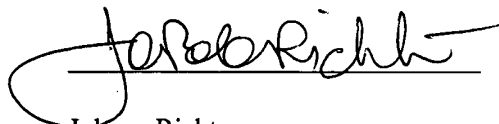
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola whose telephone number is (703) 308-4690.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Johann Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.


Johann Richter

Supervisory Patent Examiner

Group 1613

January 4, 1999